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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,388	09/26/2003	Beatrice Toumi	05725.1243-00000	2739
22852 7590 01/07/2008 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER MERCIER, MELISSA S	
			ART UNIT 1615	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/670,388

Applicant(s)

TOUMI ET AL.

Examiner

Melissa S. Mercier

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-140 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 18, 26-30, 33-39, 41-44, 70, 77-102, 110, 114-140 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 9-7-05, 7-30-07.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

Continuation of Disposition of Claims: Claims withdrawn from consideration are 16,17,19-25,31,32,40,45-69,71-76,102-109 and 111-113.

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 16-17, 19-25, 31-32, 40, 45-69, 71-76, 102-109, and 111-113 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on October 9, 2007.

Applicant's election with traverse of claims 1-15, 18, 26-30, 33-39, 41-44, 70, 77-102, 110, and 114-140 in the reply filed on October 9, 2007 is acknowledged. The traversal is on the ground(s) that searching all species does not constitute a search burden on the examiner. This is not found persuasive because restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);

(d) the prior art applicable to one invention would not likely be applicable to another invention;

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

The requirement is still deemed proper and is therefore made FINAL.

### ***Information Disclosure Statement***

Receipt of the Information Disclosure Statements filed on September 7, 2005 and July 30, 2007 is acknowledged.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 137 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 137, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9, 14-15, 26-29, 37-38, 79, 86-89, 91-98, 102, and 114 rejected under 35 U.S.C. 102(b) as being anticipated by Papantoniou et al. (US Patent 4,032,628).

Papantoniou discloses an emulsion comprises an oil phase and a water phase emulsified with an emulsifying agent consisting essentially of at least one block polymer containing both at least one lipophilic sequence and at least one hydrophilic sequence (abstract). Representative monomers that can be used to form hydrophilic sequences include, for instance, 2-(N,N-diethylamino) ethyl methacrylate; 2-(N,N-dimethylamino) ethyl glycol methacrylate; and 2-(N,N-diethylamino) ethylglycol methacrylate (column 4, lines 8-17). The block polymers used generally have a molecular weight ranging between 1000 and 1,000,000 (column 4, lines 23-31). The oil phase may include, for example, hydrocarbon oils, such as paraffin oil, liquid Vaseline, perhydrosqualene, solutions of microcrystalline wax in paraffin oil and Purcellin oil; animal or vegetable oils such as horse oil, lard, sweet almond oil, callophyllum oil, olive oil, avocado oil, these oils being well absorbed by the skin; saturated esters that do not become rancid and that are satisfactorily penetrating, such as isopropyl palmitate, isopropyl myristate, ethyl palmitate, diisopropyl adipate and octa and decanoic acid triglycerides (column 4, line 65 through column 5, line 9).

Papantoniou discloses the same claimed components as the instant claims; therefore, it would inherently possess the same functional limitations as the instant claims. Additionally, the claim terminology "capable of" is recited in the base claim. This terminology is considered to be an optional component and therefore not a required limitation of the instant claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 34-36, 42-44, 99-101, 115-117, and 131-140 are rejected under 35 U.S.C. 103(a) as being unpatentable over Papantoniou et al. (US Patent 4,032,628).

Papantoniou is discussed above and applied in the same manner.

Papantoniou does not disclose the packaging configuration of the disclosed cosmetic formulation or specific percentages of the block polymers present.

Applicant is reminded that where the general conditions of the claims are met, burden is shifted to applicant to provide a patentable distinction. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. See *In re Aller*, 220 F.2d 454 105 USPQ 233,235 (CCPA 1955).

Furthermore the claims differ from the reference by reciting various concentrations of the active ingredient(s). However, the preparation of various sanitizing compositions having various amounts of the active is within the level of skill of one having ordinary skill in the art at the time of the invention. It has also been held that the mere selection of proportions and ranges is not patentable absent a showing of criticality. See *In re Russell*, 439 F.2d 1228 169 USPQ 426 (CCPA 1971).

Papantoniou discloses a cosmetic composition. Depending on the intended use, one of ordinary skill in the art would have been motivated to package a composition in a



kit. Kits provide a convenient mechanism to disperse products to consumers, as a kit would provide a convenient mechanism to disperse a cosmetic product to consumers. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to package a cosmetic imposition, such as the one advanced in the instant application, in a kit.

Claims 1-15, 18, 26-30, 33-39, 41-44, 70, 77-102, 110, and 114-140 rejected under 35 U.S.C. 103(a) as being unpatentable over Galleguillos et al. (US Patent 6,410,005).

Galleguillos discloses AB block copolymer comprising a soft hydrophobic and a hard, hydrophilic blocks with two or more distinct glass transition temperatures, represented by Structures 1 and 2 (column 4, lines 44-65). Also disclosed is a process of polymerizing a polyfunctional monomer X within the scope of the instant intermediate block constituent (column 4, structures 1 and 2) with a first ethylenically unsaturated monomer(s) to form an A block, and subsequently polymerizing a second ethylenically unsaturated monomer(s) containing at least one carboxylic acid group with the A block to form a B block, and the resultant block copolymer (column 3, lines 53-60; column 4, lines 18-43; column 5, lines 2- 4; column 6, line 27 through column 7, line 57). Thus, a copolymer containing blocks of  $-(B)_p-X-(B)_q-$ , and  $-(A)_n-A-X-A-(A)_n-$  is formed, wherein X is a multifunctional monomer that links A and B block. The linkage of X-X reads on the

instant intermediate block, wherein X is also a constituent monomer of the A and B blocks in  $-(B)_p-X-(B)_q-$ , and  $-(A)_n-A-X-A-(A)_n-$

Absent of specific compositional and architectural details defined for the instant intermediate block, prior art  $-B-X-X-A-$  linkages in structures 1 and 2 fall within the scope of the instant intermediate block as both block A and B contains at least one constituent X, as defined in the present claims.

Galleguillos also teaches an average molecular weight of the resultant block copolymer of up to 1,000,000, having film forming property and water dispersibility (column 6, lines 3-5). Additionally, the weight percent of each of the monomers in the mixture can vary, depending on the desired properties of the final copolymer product. In one embodiment, 28 wt% to about 60 wt% of monomer A for A block and about 38 wt% to about 60 wt% of monomer B, for B block (column 13, lines 1-8). Suitable hydrophobic monomer A includes the various (meth)acrylates, (meth)acrylamides expressed in the claims, with preferred species such as n-butyl acrylate, ethyl acrylate and 2-ethylhexyl acrylate which read on the instant low T<sub>g</sub> monomeric species (column 7, line 65 to column 9, line 2). Galleguillos's preferred hydrophilic monomer B include ethylenically unsaturated carboxylic acid such as (meth)acrylic acid, along with the disclosed alkyl methacrylates, block having T<sub>g</sub> greater than or equal to 40°C (column 10, line 57 to column 11, line 30). Galleguillos also specifically discloses using varying proportion of mixtures of A and B monomers so as to achieve the desired balance of the resultant block polymer properties (column 12, lines 12-15; column 13, lines 1-8).

Galleguillos further discloses the copolymers may be delivered from aqueous or hydro alcoholic solutions, dispersions or emulsions. The copolymers may be dissolved in water, water-ethanol, or water solvent mixtures by dispersing the copolymer in solvent and adjusting the pH with an organic or inorganic base (column 13, lines 55-62) and incorporated into a nail formulation (column 14, lines 30-32). The formulation may further comprise formulation additives including fragrances, dyes and colorants, plasticizers, emulsifiers, UV absorbers, lubricants and penetrates (column 14, lines 20-28). Additional optional resins may also be incorporated (column 18, lines 54-65).

Prior art discussed above provide clear disclosures regarding the method and the selection of various monomers species in formation block copolymer systems having balance of hydrophilic/hydrophobic properties. The selection of hard and soft block components with differences in glass transition temperature is suggested within the scope of the present claims. Accordingly, one skilled in the art would have readily envisaged the selection of the suitable monomers having Tg differences as taught, motivated by the reasonable expectation of success in forming block copolymers with balanced hydrophilic/hydrophobic characteristics. Once the respective monomer block components are suggested with Tg consideration, the determination of their optimum proportions or workable ranges taught within the general disclosures of prior art, would involve only routine skill in the art. Some of the references discussed are silent regarding the polydispersity index expressed in the present claims, the examiner is of the position that it would have been obvious and fully within the knowledge of one having ordinary skill in the art to control the

optimum molecular weight, polydispersity, polymer composition and architectures of the resultant block copolymer product by varying experimental parameters such as source, amount, and solvation of catalyst/initiators/control agents, polymerization temperature and time, etc.

Furthermore, Galleguillos discloses the same claimed components as the instant claims; therefore, it would inherently possess the same functional limitations as the instant claims. Additionally, the claim terminology "capable of" is recited in the base claim. This terminology is considered to be an optional component and therefore not a required limitation of the instant claim.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-15, 18, 26-30, 33-39, 41-44, 70, 77-102, 110, and 114-140

provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-121 of copending Application No. 10/670478.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they contain overlapping subject matter, specifically the block copolymer and the use of the copolymer in a cosmetic formulation. It is readily known in the art to use block copolymers in nail compositions, therefore, it would have been obvious to envision such a cosmetic formulation.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Frechet et al. (US Patent 6,663,885 and 6,685,925); Schimmel et al. (US 6,197,883); and Anton et al. (US 6,153,206).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa S. Mercier whose telephone number is (571) 272-9039. The examiner can normally be reached on 7:30am-4pm Mon through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone

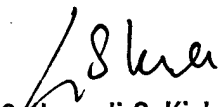
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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MSMercier

  
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